

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Federico T. Marques	Group Art Unit: 1744
Serial No.: 10/001,778	Examiner: Thornton, KM
Filed: October 23, 2001	Atty. Dkt. No.: 20097.0002.NPUS00 (previously 97007/01C1)
Title: AN AIR FILTERING APPARATUS AND METHODS FOR USING SAME	Confirmation No: 3051

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES

Applicant is filing herewith a petition under 37 C.F.R. § 1.181 to request that the holding of abandonment of U.S. Pat. App. No. 10/001,778 be withdrawn because Applicant's reply to the Office Action dated December 8, 2004 should be found to have been sufficient. Applicant is filing the present petition under 37 CFR § 1.183 to waive the requirement of 37 C.F.R. § 1.181(f). 37 CFR § 1.183 allows for the Director to suspend any requirement of the regulations in an extraordinary situation when justice requires.

According to PAIR, a Notice of Abandonment was mailed regarding U.S. Pat. App. No. 10/001,778 on February 16, 2005 stating that the application is abandoned in view of Applicant's failure to timely file a proper reply to the Office letters mailed on August 6, 2004 and March 23, 2004. The March 23, 2004 letter is a Non-Final Office Action and the August 6, 2004 letter is a Notice of Non-Compliant Amendment. The client's former attorney, Mr. Robert Strozier, filed responses to the Office Action mailed March 23, 2004 on July 23, 2004 and December 8, 2004 that were deemed non-compliant.

The July 23, 2004 response was held non-compliant because new paragraphs were underlined (a paragraph to be added regarding related applications was underlined), a complete listing of all of the claims was not present (Claims 1-8 and 10-20 were not present and identified as canceled), “presently added” was used as a status identifier instead of “presently presented”, and Claim 9 was included but had been previously cancelled in an amendment filed October 23, 2001. August 6, 2004 Notice of Non-compliant Amendment. The December 8, 2004 response remedied those issues except that the status identifier “previously added” was used instead of “previously presented.” Applicant’s counsel explained that Claim 9 was inadvertently canceled in the October 23, 2003 Preliminary Amendment. However, the date of the Preliminary Amendment should have been listed by Applicant’s counsel as October 23, 2001. The PTO sent a Notice on December 21, 2004 that December 8, 2004 response was not compliant because the status identifier “previously added” was used instead of “previously presented.”

Under 37 C.F.R. § 1.183, this is an extraordinary situation where justice requires that the rule in 37 C.F.R. § 1.181(f), that a petition may be dismissed as untimely if not filed within two months of the mailing date of the action or notice from which relief is requested, be suspended or waived by the Director. The extraordinary situation is the United States Patent and Trademark Office’s Notice the July 5, 2005 Official Gazette of the provision of 37 C.F.R. § 1.121(c) that required “previously presented” included that a response would not be held non-compliant for use of “previously added” instead of “previously presented.” Had Applicant’s counsel filed the response a mere seven months later, the response would not have been considered non-compliant and the application would not have received a Notice of Abandonment. This fact, coupled with the failure of counsel to seasonably take advantage of this provision, and seasonably inform the client of the Office Action, Notices of Non-compliant Reply, or of the Notice of Abandonment indicate that justice requires that 37 C.F.R. 37 CFR § 1.181(f) be waived and the holding of abandonment withdrawn.

Applicant should not have to suffer the abandonment of his patent application due to a word choice by former counsel that later would not have been sufficient to hold the reply non-compliant. Applicant has not intentionally delayed the filing of a petition to withdraw the holding of abandonment under 37 CFR 1.181(f). Applicant respectfully requests that the holding

of abandonment of U.S. Pat. App. No. 10/001,778 be withdrawn.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application. The undersigned representative authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 20097.0002.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

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Respectfully submitted,

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